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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,633	08/28/2003	Daniel Gelbart		5552

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EXAMINER

FERGUSON, MARISSA L

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/649,633

Applicant(s)

GELBART, DANIEL

Examiner

Marissa L Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 8 and 13 are objected to because of the following informalities:
claim 8 depends upon itself. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,3,7-11,14,16-19 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Jaynes (US Publication 2004/0076803).

Regarding claim 1, Jaynes teaches a method for dispensing the authentication material in powder form over the article before the ink is fully cured (Page 4, Paragraph 0034, Lines 1-20).

Regarding claim 2, Jayne teaches a method for dispensing a spray powder for preventing printed articles from adhering to other objects and wherein dispensing the authentication material and dispensing the spray powder are performed by the same equipment (Page 4, Paragraph 0034). Also, the claimed

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spray powder comprises a mixture of particles and/or additives that can be identified as authentication materials.

Regarding claim 3, Jaynes teaches a method comprising mixing the authentication material with the spray powder prior to dispensing the authentication material and prior to dispensing the spray powder (Page 4, Paragraph 0034, Lines 1-20).

Regarding claim 7, Jaynes teaches a method comprising applying ink to the printed article, and before the ink applied to the printed article is cured, applying a powder comprising an authentication material atop the ink (Page 4, Paragraph 0034, Lines 1-20).

Regarding claim 8, Jaynes teaches a method comprising allowing the powder to adhere to uncured ink (Paragraph 0034, Lines 15-18).

Regarding claim 9, Jaynes teaches a powder comprising authentication material comprising a mixture of the authentication material with a spray powder for preventing printed articles from adhering to other objects (Page 4, Paragraph 0034, Lines 1-20).

Regarding claims 10,11,18 and 19, Jaynes teaches a method comprising applying ink to the printed article and applying powder comprising the authentication material atop the ink are performed in a printing press (Page 3, Paragraph 0033, Lines 1-4).

Regarding claim 14, Jaynes teaches a method comprising curing the ink and thereby bonding the ink to the authentication material (Page 2, Paragraph 0023).

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Regarding claim 16, Jaynes teaches mixing an authentication material with a spray powder for preventing printed articles from adhering to other objects to form a powder mixture, applying ink to the printed article and prior to the ink curing on the printed article applying the powder mixture to the printed article atop the ink (Page 4, Paragraph 0034).

Regarding claim 17, Jaynes teaches allowing the powder mixture to adhere to the uncured ink (Page 4, Paragraph 0034, Lines 1-20).

Regarding claim 22, Jaynes teaches curing the ink and thereby bonding the ink to the authentication material (Page 4, Paragraph 0034, Lines 1-20).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaynes (US Publication 2004/0076803) in view of Sekioka et al. (US Publication 2003/0220419).

Regarding claim 4, Jaynes teaches a method comprising after applying ink to the printed article, dispensing a powder form over the article before the ink is fully cured (Page 4, Paragraph 0034, Lines 1-20). However, he does not explicitly disclose spraying a light activated authentication material. Sekioka et

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al. teaches a database deciphering method with a light activated fluorescent material (Abstract, Paragraph 0010 and Paragraph 0012).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as taught by Jaynes to include a fluorescent powder as taught by Sekioka et al., since Sekioka et al. teaches it is advantageous to provide a fluorescent powder in order to prevent forgery, manage maintenance and facilitate handling of products or commodities.

Regarding claims 15 and 23, Jaynes and Sekioka et al. both teach the method including an authentication material with a density except an authentication material with a density of 0.3 mg/m^2 . However, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It would have been obvious to provide an authentication material with the claimed density, since such a modification would result in a material having a required density so that it can be readily detectable.

4. Claims 5,13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaynes (US Publication 2004/0076803) in view of Sekioka et al. (US Publication 2003/0220419) as applied to claim 1 above, and further in view of Hayosh (US 6,600,823).

Jaynes and Sekioka et al. both teach the method except for an authentication material comprising a magnetic authentication material. Hayosh teaches an invention for a self-authenticating document with a magnetic strip (Column 1, Lines 28-32). It would have been obvious at the time the invention

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was made to a person having ordinary skill in the art to further modify the invention as taught by Jaynes to include a magnetic material as taught by Hayosh, since Hayosh teaches it is advantageous to provide a magnetic strip for storing important document information.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jaynes (US Publication 2004/0076803) in view of Sekioka et al. (US Publication 2003/0220419) as applied to claim 1 above, and further in view of Itakura et al. (US Publication 20002/0129251).

Jaynes and Sekioka et al. both teach the method except for an authentication material comprising biological authentication material. Itakura et al. teaches a method for individual authentication with DNA authentication marks (Page 2, Paragraph 0034, Lines1-4). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention as taught by Jaynes to include DNA material as taught by Itakura et al., since Itakura teaches it is advantageous to prevent illegal acts such as substitution of a photograph.

6. Claims 12,20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaynes (US Publication 2004/0076803) in view of Varn International (www.varn.com/powders).

Regarding claims 12,20 and 24, Jaynes teaches the method claimed, however he does not explicitly disclose an authentication powder and spray powder having dimensions of 20-50 μ m. The claimed dimensions appear to be a common feature as noted by Varn International (located at the bottom of the

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website). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention as taught by Jaynes to include the claimed dimensions as taught by Varn International, since Varn International teaches it is advantageous to compensate for the weight and height of the paper stack as it increases.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jaynes (US Publication 2004/0076803) in view of Varn International (www.varn.com/powders) as applied to claim 24 and further in view of Hayosh (US 6,600,823).

Jaynes and Varn International both teach the method except for an authentication material comprising a magnetic authentication material. Hayosh teaches an invention for a self-authenticating document with a magnetic strip (Column 1, Lines 28-32). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention as taught by Jaynes to include a magnetic material as taught by Hayosh, since Hayosh teaches it is advantageous to provide a magnetic strip for storing important document information.

Response to Arguments

8. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

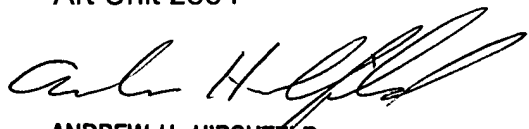
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa L Ferguson whose telephone number is (571) 272-2163. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other (F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Examiner
Art Unit 2854



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